RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1631

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

James N. CAWSE Group Art Unit: 1631

Application No.: 09/938,763 Examiner: Cheyne D. Ly

Filed: August 27, 2001

For: METHOD AND SYSTEM TO INVESTIGATE A COMPLEX CHEMICAL SPACE

MPEP 706.07(c) AND MPEP 706.07(d) REQUEST TO WITHDRAW FINAL REJECTION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Primary Examiner is requested to withdraw the February 24, 2004 Final Rejection for the following reasons:

1. Claims 1 to 7, 9 to 10, 13 to 15, 17 to 36 and 39 to 42 are pending.

2. The February 24, 2004 Final Rejection rejected claims 1 to 7, 9 to 10, 13 to 15, 17 to 36 and 39 to 42 under 35 U.S.C. 112, second paragraph; under 35 U.S.C. 112, first paragraph; and under 35 U.S.C. 103(a).

I. THE FEBRUARY 24, 2004 FINAL REJECTION INCORRECTLY EXAMINES THE CLAIMS UNDER 35 U.S.C. §103(A)

3. Claim 1 in this application claims "a step of "defining an experimental space of a catalyzed chemical reaction to represent at least three factor interactions, wherein the factors comprise a catalyst system and conditions."

4. All remaining claims depend from claim 1.

5. The February 24, 2004 Final Rejection rejects claim 1 under 35 U.S.C. §112, second paragraph, 35 U.S.C. §112, first paragraph and 35 U.S.C. §103(a).

6. The Final Rejection states the sole basis for the 35 U.S.C. §103(a) rejection of claim 1 is "the vague and indefinite issue" (the 35 U.S.C. §112, second paragraph rejection) (February 24, 2004 Final Rejection paragraph 22).

7. An outstanding 35 U.S.C. §112, second paragraph rejection does not relieve the PTO from the prima facie requirement that is prerequisite to applying a 35 U.S.C. §103(a) rejection. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

8. 37 C.F.R. § 1.104 entitled "Nature of Examination" provides that "[t]he examiner's action will be complete as to all matters...."

9. 37 CFR 1.104 entitled "Nature of examination" provides that

> In rejecting claims for want of novelty or for obviousness... the particular part [of a reference] relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 CFR 1.104 (c) (2).

10. The MPEP 2271 states:

> .... The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal.....

11. Failure to provide basis for the 35 U.S.C. 103(a) rejection of claim 1 is incomplete examination, not in accord with the Patent Rules or proper PTO practice.

12. The finality of the February 24, 2004 Final Rejection should be withdrawn and the claims allowed or a proper office action issued.

II. THE FEBRUARY 24, 2004 FINAL REJECTION APPLIES AN IMPROPER STANDARD OF EXAMINATION

13. 35 U.S.C. 103(a) rejections are based on 35 U.S.C. 102(a) stating "A person *shall* be entitled to a patent *unless* (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent..." (emphasis added). A patent must be issued *unless* the PTO establishes a reason not to issue the patent; for example, by establishing a prima facie case of obviousness.

14. With respect to a prima facie case, MPEP 2142 points out that:

> .... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

MPEP 2142.

15. The Final Rejection states that "Applicant's arguments have been fully considered and found to be unpersuasive" (Final Rejection page 5); "Applicant's argument (via questions) have been fully considered and found to be unpersuasive as discussed below" (Final Rejection page 6); "Applicant's arguments have been fully considered and found to be unpersuasive as discussed below" (Final Rejection page 7); and "[s]pecific to Applicant's argument that the "controller" in the Agrafiotis et al, reference is distinct from that of the instant invention, said argument has been fully considered and found to be unpersuasive as discussed below" (Final Rejection page 8).

16. "Persuasiveness of an Applicant's argument is not a correct 35 U.S.C. 103(a) standard of examination.

17. The correct 35 U.S.C. §103(a) standard of examination is whether the PTO has met its burden of establishing a *prima facie* case of obviousness. *See In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1992) and *See In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

18. Weighing persuasiveness of an Applicant's arguments instead of meeting a prima facie burden, applies an incorrect standard or examination.

19. The finality of the February 24, 2004 Final Rejection should be withdrawn and the claims allowed or examined according to a proper standard of patentability.

III. CONCLUSION

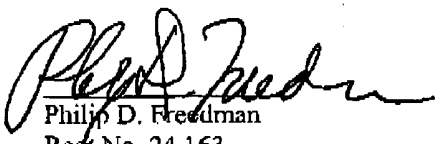
20. The PTO has failed to provide basis for the 35 U.S.C. 103(a) rejection of claim 1. The February 24, 2004 Final Rejection is a premature final rejection.

21. The PTO has not examined the claims according to a proper 35 U.S.C. §103(a) proof standard. The February 24, 2004 Final Rejection is a premature final rejection.

22. This Request to Withdraw the Final Rejection is filed pursuant to MPEP 706.07(c) and MPEP 706.07(d) as prerequisite to Petition to the Commissioner of Patents.

Applicant respectfully requests the PTO to withdraw the February 24, 2004 Final Rejection, allow the application or reissue a non-final office action, restarting the period for response.

Respectfully submitted,



Philip D. Freedman
Reg. No. 24,163
Philip D. Freedman PC
Customer Number 25101
P.O. Box 19076
Alexandria, Virginia 22320
(703) 706-5327
Email: tekesq@tekesq.com

Alexandria, Virginia
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